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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,148	10/14/2003	Minoru Kawahara	450100-04787	4785
FROMMER LAWRENCE & HAUG LLP 745 FIFTH AVENUE NEW YORK, NY 10151			EXAMINER SHIBRU, HELEN	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 09/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/685,148	KAWAHARA, MINORU	
	Examiner	Art Unit	
	HELEN SHIBRU	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 8,10,18,20,28 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-17,19,21-27 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/06&03/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Claims 8, 10, 18, 20, 28, and 30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 07/19/2007.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 9, 11-17, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishige (US PG PUB 2002/0057894 A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Ishige discloses a data processing apparatus comprising: a detector for detecting completion of preparations (editing) for outputting first data read from a data recording medium which stores said first data and second data corresponding to said first data and having a data amount smaller than that of said first data (see fig. 1 where it shows encoders

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of low and high resolution data and claim 1 and paragraphs 0025-0029); and a selector for selectively outputting said second data read from said data recording medium until the completion of said preparations for outputting said first data is detected, said selector further outputting selectively said first data once the completion of said preparations for outputting said first data is detected (see paragraphs 0037-0044).

Regarding claim 2, Ishige discloses a first controller for controlling reproduction of said first data; and a second controller for controlling reproduction of said second data; wherein said first controller controls the reproduction of said first data in response to the reproduction of said first data controlled by said second controller (see fig. 1 and paragraphs 0027-0028).

Regarding claim 3, Ishige discloses first data and said second data corresponding to said first data are stored intermittently on said data recording medium (see paragraphs 0036 and 0041).

Regarding claim 4, Ishige discloses first data are video data and said second data are video data obtained by lowering resolution of the video data constituting said first data (see abstract).

Regarding claim 5, Ishige discloses a resizer for resizing the video data constituting said second data into the same size as that of said first data (see paragraphs 0026-0028).

Regarding claim 6, Ishige discloses a decoder for decoding said first data furnished as encoded data; wherein said detector detects completion of preparations for outputting results of the decoding performed by said decoder (see paragraphs 0041-0044).

Regarding claim 7, Ishige discloses a reader for reading said first data and said second data from said data recording medium (see fig. 1 components 3 and 4).

Regarding claim 9, Ishige discloses first data are made up of a continuous collection of clips, said first data being reproduced on a clip by clip basis, said data processing apparatus further comprising: a position calculator for calculating a current clip read ending position and a next clip read starting position, said current clip read ending position being the position in which to end reading of the currently reproduced clip from said data recording medium, said next clip read starting position being the position from which to start reading from said data recording medium the clip to be reproduced next following the current clip; and wherein said reader stops reading of the current clip from said data recording medium in said current clip read ending position and starts the reading of the next clip from said next clip read starting position (see paragraphs 0041-0044 and claims 1-9).

Method claims 11-17 and 19 are rejected for the same reasons as discussed in claims 1-7 and 9 above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishige in view of Official Notice.

Regarding claim 21-27 and 29, the limitations in claims 21-27 and 29 can be found in the apparatus claim 1-7 and 9 respectively. However claims 21-27 and 29 further require a program to perform steps as claimed in claims 1-7 and 9. Official notice is taken that it is well known in

the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Ishige by having a software program to execute the steps of the method claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 21-27 and 29 are rejected under 35 U.S.C. 101 because the claims are directed to a recording medium storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. See, e.g. Warmerdam, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. In addition a mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship either as part of the stored data or as part of the computing processes performed by the computer then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer, and therefore are not statutory. See MPEP 2106.IV.B.1.

Conclusion

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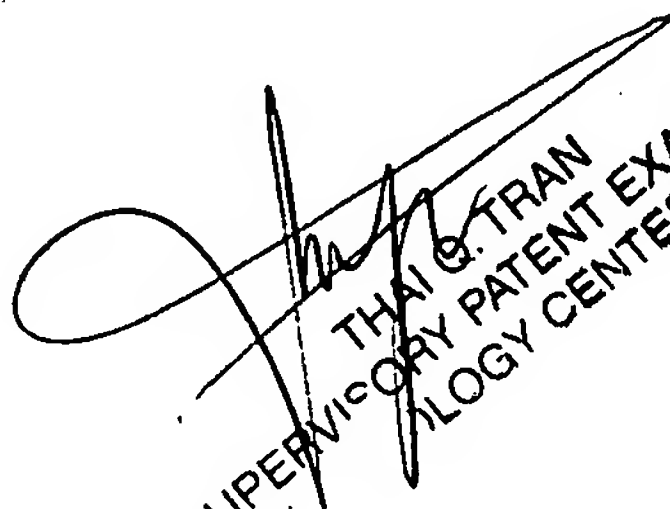
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329.

The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru
September 8, 2007


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